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OFFICE OF PETITIONS

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In re Application :
Hisashi Yamada et al. :
Application No. 10/046,739 : DECISION ON APPLICATION
Filed: January 17, 2002 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. 3885-0102P :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b) filed May 7, 2010. Applicant requests that the determination of patent term adjustment be corrected from 1443 days to 2552 days.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not

calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **DISMISSED**.

On March 15, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date is 1443 days.

In response, applicant timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 C.F.R. § 1.18(e). Applicant requests that the patent term adjustment be corrected to 2552 days.

Applicant contends that the patent term adjustment for Examination delay should be increased for the failure of the USPTO to provide an Office Action in the present application. Specifically, applicant contends that in connection with an erroneous Notice of Abandonment mailed on July 28, 2003, for which a Petition to Withdraw the Holding of Abandonment was submitted on August 20, 2003, Applicant should be entitled to PTA for all of the days from 14 months from filing the present application, namely, March 17, 2003; until the first Office Action issued on October 28, 2009.

Applicant further states that the patent issuing from the application is not subject to a terminal disclaimer.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) (I) provides for patent term adjustment:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after —

(I) the date on which an application was filed under section 111(a) of this title;

37 C.F.R. § 1.702 provides that:

(a) Failure to take certain actions within specified time frames . Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

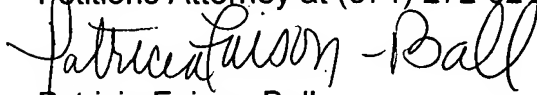
OPINION

The application history has been reviewed and it has been determined that the initial patent term adjustment of 1443 days is correct. The Office mailed a Restriction Requirement, the first Office Action, on November 20, 2002, within fourteen months of the date after the date on which the application was filed , January 17, 2002. Accordingly, this led to no increase in the period of adjustment.

In this case, the mailing of the Decisions on Petition granting the applicants' Petitions to Withdraw the Holding of Abandonment for failure to receive the Restriction Requirements, does not alter the date used in calculation of the period of adjustment. The record reveals the Office Actions were mailed to the correspondence address of record. The record does not support a conclusion that the Notice was "incorrectly" mailed by the Office. Rather, the record indicates that the properly addressed Office Action was not received. It has not been shown that the failure to receive was due to any error on the part of the Office in mailing the first Restriction Requirement. Thus, the mailing of the non-Final Office Action on October 28, 2009 is not the first Office Action mailed within the meaning of 35 U.S.C. 154(b).

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with a large, prominent "P" and "B".

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions